



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appl. No. : 10/801,401
Applicant(s) : Clements, Jehan
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Examiner : Nikolai A. Gishnock
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Customer No. : 27171
Title : *Flip-Over Storytelling Book Publishing System, Method, and Kit*

**MAIL STOP APPEAL BRIEF – PATENTS
COMMISSIONER OF PATENTS
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**REPLY BRIEF TO THE BOARD OF PATENT APPEALS
AND INTERFERENCES UNDER 37 C.F.R. § 41.41**

In response to the Examiner's Answer dated March 16, 2010 (the "Examiner's Answer"),
Applicant respectfully submits the following Reply Brief.

In view of the following arguments, and in view of the arguments in the Appeal Brief
filed September 30, 2009 (the "Appeal Brief"), Applicant respectfully requests reconsideration
and allowance of the pending claims.

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I. STATEMENT OF TIMELINESS

This is a Reply Brief to the Examiner's Answer, and it is being filed on May 17, 2010.

This Reply Brief is timely as it is filed within two (2) months of the Examiner's Answer pursuant to 37 C.F.R. 41.41, as the two-month date falls on Sunday, May 16, 2010. In addition, a Request for Oral Hearing and the required fees are concurrently filed pursuant 37 C.F.R. 41.47.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The Examiner has not presented any new grounds of rejection in his Answer. Thus, as stated in the Appeal Brief, the grounds of rejection to be reviewed on appeal continue to be based on a rejection of claims 21-24, and 26-29 under 35 U.S.C. § 103(a), contained in the Examiner's Answer, as being unpatentable over *Gonzales* (U.S. Patent Publication No. 2002/0161603). in view of *Scocca* (U.S. Patent No. 6,126,202), *Clements '172* (U.S. Patent No. 6,210,172) and *Schubert* (U.S. Patent No. 5,127,879). In addition, further grounds for rejection to be reviewed on appeal are based on the rejection of claims 31-34 under 35 U.S.C. § 103(a), contained in the Examiner's Answer, as being unpatentable over *Gonzales*, *Scocca*, *Clements '172*, *Schubert* and *Schach* (U.S. Patent No. 5,397,156).

III. ARGUMENTS

Applicant submits this Reply Brief to rebut arguments raised in the Examiner's Answer. Specifically, the Examiner's combination of prior art references, and therefore the basis for his obviousness rejections, respectfully, (1) is based on a misinterpretation of the scope and content of the prior art; (2) relies on a prior art reference that teaches away from the present invention;

and (3) is founded on an improper determination that the printed matter in the claimed invention is not functionally related to the substrate. Therefore, for these reasons -- and those contained in the Appeal Brief -- the cited references do not render the presently claimed invention obvious to one of ordinary skill in the art.

A. The Combination of Prior Art References is Based on a Misinterpretation of the Scope and Content of the Prior Art

In its answer, the Examiner has, respectfully, extended and transformed the teachings and disclosure of cited prior art references beyond the knowledge of one of ordinary skill in the art. For example, contrary to the Examiner's arguments, nowhere in *Gonzales* does it teach disclose, or even mention "book publishing templates" -- let alone one with the precise functionality of the presently claimed invention (Examiner's Answer, pp. 6, 7, 20, 21 and 22). Rather, *Gonzales* describes a webpage publishing system focused on the distributed workflow of publishing articles on a website (*Gonzales*, ¶¶ 0033-0034) (emphasis added). The term "publish" in *Gonzales* means to "to post material to the site, *i.e.*, to 'go-live' on the site" (*Gonzales*, ¶ 0032). Authors have the ability to (i) create articles for their posting to a website, (ii) add content to articles, (iii) edit articles, and (iv) delete articles (*Gonzales*, ¶¶ 13-14, 32, 34, 60, 68-69, 79, 83, 94, 139). In creating an article, authors use webpage templates, and insert content into the templates (*Gonzales*, ¶¶ 0019, and 0052; Fig. 5). Moreover, unlike the present invention, *Gonzales* teaches pure "*what you see is what you get*" (WYSIWYG) functionality (Appeal Brief, p. 12, ll. 7-12).

The Examiner's interpretation of *Gonzales*'s reading on the presently claimed invention is based on the notion that under a broadest reasonable interpretation, the claim term "story book screen" "impl[ies] a web site for applying the claimed method" (Examiner's Answer, p. 23).

Respectfully, the Examiner's argument looks merely at the input of the presently claimed invention and not the output. Specifically, the Examiner's argument requires a finding that one of ordinary skill in the art at the time of the invention would have modified a WYSIWYG website development program to a hard-copy book assembly system with such precise outputs as to generate story pages for printing on particular sides of a paper with specific images enlarged and certain text used on particular sides of the paper where the printed and bound result has the second story page in diametric contraposition to the first story page. In other words, in the present invention, the information automatically generated on the odd-numbered pages is directly input by the user in blank storybook screens, while the information automatically generated on the even-numbered pages is automatically generated from a transformed version of the user input. The additional teachings of *Scocca*, *Clements '172*, and *Schubert* do not bring the knowledge of one of ordinary skill in the art any closer because all of those references teach WYSIWYG systems and methods. For example, *Scocca* discloses a WYSIWYG book publishing kit employing WYSIWYG templates at *Scocca* 1:6-8, 1:37-44, 2:13-31, 3:39-47, and Figs. 1, 4-7; *Clements '172* discloses a WYSIWYG "do-it-yourself" storytelling book invention employing WYSIWYG insertion pages at *Clements '172* 1:14-22, 4:61-5:18, 5:25-31, 6:11-14, 6:24-48, and Figs. 1, 2, 5; and *Schubert* discloses a WYSIWYG record keeping system employing a WYSIWYG accordion-folded paper at *Schubert* 2:32-39, 3:9-33, Figs. 1, 2A-3B.

Applicant further notes that "[i]n order to render a claimed apparatus or method obvious, the prior art must enable one skilled in the art to make and use the apparatus or method."

Beckman Instruments, Inc. v. LKB Produkter AB, 892 F.2d 1547, 1551 (Fed. Cir. 1989)(citing *In re Payne*, 606 F.2d 303, 314 (CCPA 1979)). The Examiner's cited prior art, taken as a whole, with the knowledge of one of ordinary skill in the art, does not enable one skilled in the art to

make and use the claimed invention because the Examiner has only cited references that employ a WYSIWYG method of solving problems in the art.

B. Clements '172 Teaches Away From The Present Invention

In rebuttal of Applicant's arguments that Clements '172 teaches away from printing on both sides of a sheet of paper (Appeal Brief, p. 30, l. 22 to p. 31, l. 14), the Examiner states that "prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives, because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed" (Examiner's Answer, p. 27). However, there are no alternatives to one sided printing in *Clements '172* and no alternatives to WYSIWYG methodology. Indeed, the Examiner has not made any reference to an alternative embodiment disclosed in *Clements '172* that employs *printing on both sides of the sheet* nor transforming the input such that contains different non-WYSIWYG output. As stated in the Appeal Brief, *Clements '172* at 6:24-26 discloses that "[t]he insertion pages are preferably *one-sided* for use with clear loose-leaf holders having a stiff opaque insert" (emphasis added). *See also Clements '172*, 6:7-10 and 6:54-56; Figs. 1 and 2. This one-sided insertion page aspect of *Clements '172* clearly teaches away from the present invention and leads one of ordinary skill in the art to a divergent path of using one-sided insertion pages.

C. The Present Invention Teaches Printed Matter That is Functionally Related to the Substrate, and Therefore Patently Distinguishable from Prior Art

Independent claims 21, 26, and 31 of the present invention include the limitation of automatically generating "one or more indicia on the title page and first and second story pages

for indicating how to assemble the second story page in diametric contraposition to the first story page". In connection with these aspects of the present invention, the Examiner at the Examiner's Answer p. 24 avers that

such is mere nonfunctional descriptive material, not tied to the substrate; this content is functional only in the subjective mind of the user and fails to change the function of the references as a whole, as Gonzales would be used [sic] publish, print, and bind any such content as desired by a user. The content of the instructions specifically is addresses [sic] in *Ngai*, *Id.* and explicitly taught in Clements ['172]; it is nonfunctional descriptive material because the contents of the book and instructions fail to change the way the computer program of Gonzales functions; thus, appellant's arguments are incorrect.

In stating that the indicia are "nonfunctional descriptive material because the contents of the book and instructions fail to change the way the computer program of Gonzales functions," the Examiner applies an incorrect inquiry. Rather, the relevant test for whether printed matter will distinguish the invention from the prior art is whether the printed matter in question is "functionally related to the substrate". *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004) (citing *In re Gulack*, 703 F.2d 1381, 1387 (Fed. Cir. 1983)). Namely, the Examiner has incorrectly identified the substrate as the "computer program," when it is rather the automatically generated pages of the storytelling book—the claims read "one or more indicia *on the title page and first and second story pages*" (emphasis added). Furthermore, under 35 U.S.C. § 103, in examining claims for patentability, one "cannot dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable. The claim must be read as a whole." *Gulack*, 703 F.2d at 1385.

In *Ngai*, the inventor Ngai claimed the combination of a known product and a set of instructions for that product. The Federal Circuit rejected the applicant's claim stating that "[h]ere, the printed matter in no way depends on the kit, and the kit does not depend on the printed matter. All that the printed matter does is teach a new use for an existing product."

Ngai, 367 F.3d at 1339. The court in *Ngai*, contrasted the claimed kit with the invention in *Gulack* wherein digits appear on a band and are interrelated by an algorithm. The Federal Circuit in *Gulack* allowed the claims because “the[] digits are related to the band in two ways: (1) the band supports the digits; and (2) there is an endless sequence of digits--each digit residing in a unique position with respect to every other digit in an endless loop.” *Gulack*, 703 F.2d at 1386-1387.

Similarly to *Gulack*, the present invention discloses the use of indicia (*i.e.*, printed matter) that depend on the substrate (*i.e.*, the generated storytelling book); namely, the indicia are functionally related to the substrate. Reading claim 21 as a whole, the indicia indicate “how to assemble the second story page in diametric contraposition to the first story page.” This is the same for claims 26, and 31. Thus, each specific indicia appearing on the title page, the first story page, or second story page depends upon the page on which they appear. That is, each indicia bear a direct relationship to other indicia appearing on other pages so as to orient the first and second story pages in diametric contraposition. Likewise, the substrate depends on the indicia, without which assembly of the pages of the storytelling book would not be in diametric contraposition. Said another way, the desired result of a storytelling book whose pages are assembled in diametric contraposition would not be achieved without the indicia. Accordingly, the indicia are functionally related to the substrate and distinguishable from the prior art.

IV. CONCLUSION

For the reasons given in this Reply Brief and in the Appeal Brief, Applicant respectfully submits that the Office has not set forth a *prima facie* case of obviousness and requests reversal of the rejection of claims 21-24, 26-29, and 31-34, and allowance of the same.

The Commissioner is authorized to charge any additional fees associated with this brief,

or credit any overpayment, to Deposit Account No. 13-3250. **EXCEPT** for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 13-3250 (Reference No. 02013.06034). This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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